

CLAIM REJECTIONS—35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1, 25, and 49 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Office Action alleged that the feature “wherein the data causes the client to request said requested content” is repetitive in view of the already existing feature “receiving, from a browser executing on a client, an initial request for requested content.” The Office Action also alleged that it is not clear how and why a client would request content that the client had already previously requested.

The Applicants do not believe that 35 U.S.C. § 112, second paragraph contains a prohibition against repetitiveness. Nevertheless, the Applicants will respond to the Office Action’s allegations with an explanation.

Claim 1 can be understood with reference to the embodiment of the invention described with reference to FIG. 3. In step 1, a user (“client”) sends, to a porthole engine, a request for requested content. In the example given, the requested content is “<http://www.cajun-gifts.com/>.” Thus, the porthole engine “receives, from a browser executing on a client, an initial request for requested content” as recited in Claim 1.

In step 2, in response to the client’s request for the requested content, the porthole engine sends porthole engine-generated frameset data to the client. Thus, “said porthole engine responding to said initial request by sending, to said client, data generated by the porthole engine” as recited in Claim 1. In such an embodiment, the porthole engine does not, yet, request the requested content from the origin server, receive the requested content from the origin server, or forward the requested content to the client in response to the request. Instead, the porthole engine sends the frameset data to the client. The frameset data is **not** the requested content.

In step 3, the browser decodes the frameset data and, upon decoding the tags for embedded items in the frameset data, sends requests for “<http://www.cajun-gifts.com/>” (the original “requested content” discussed above), “<http://some-isp.net/porthole/frame1.html>” (“unrequested content”), and “<http://some-isp.net/porthole/frame2.html>” (also “unrequested content”) to the porthole engine. Because the browser’s decoding of the tags in the frameset data causes the browser to request “<http://www.cajun-gifts.com/>” (the “requested content”) **again**, the “data causes the client to request said requested content” as recited in Claim 1.

Thus, one explanation for the apparent repetitiveness in Claim 1 is that, in the embodiment of the invention recited in Claim 1, the client **actually does request the requested content more than once**. The client needs to do so because the first request doesn’t make it to the origin server and doesn’t get the requested content for the client. The porthole engine intercepts the first request and responds to the first request with frameset data that is **not** the requested content. This frameset data causes the client to request the requested content **again**. Beneficially, the frameset data **also** causes the client to request the **unrequested** (from the perspective of the user) content. Thus, it should be clear how and why the client would request content that the client has already previously requested, as pondered by the Office Action.

With the above explanation in mind, it should be clear that the language of Claim 1 is quite definite. Thus, Claim 1 satisfies the definiteness requirement of 35 U.S.C. 112, second paragraph.

Claims 25 and 49 satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, for at least the same reasons that Claim 1 satisfies the definiteness requirement of 35 U.S.C. § 112, second paragraph.

CLAIM REJECTIONS—35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1, 25, and 49

Claims 1, 25, and 49 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleged that the feature “wherein, when said porthole engine responds to said initial request, said porthole engine has not yet obtained any copy of said requested content from said origin server” is not described in the specification. The Office Action alleges that such a feature is not **explicitly** described in the specification.

MPEP 2163 says, in part, “If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, **even if every nuance of the claims is not explicitly described in the specification**, then the adequate description requirement is **met**. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 464 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating ‘**the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient**’).” Thus, the specification does **not need** to express the features of Claim 1 **in the same words** as those recited in Claim 1.

FIG. 3 illustrates an embodiment of the invention in which the porthole engine responds to the client’s request for requested content with frameset data (which is **not** the requested content). FIG. 3 shows that **after** the porthole engine responds to the client in this manner, the requested content is obtained from the origin server. If this was the first time that the porthole engine received a request for such requested content, then, naturally, the porthole engine would not have ever obtained the requested content from the origin server at the time of the porthole engine’s initial response to the client.

The notion that a claim is not permitted to recite any phrase that is not contained, verbatim, in the specification, is a false one. 35 U.S.C. § 112, first paragraph, requires that the specification enable one of ordinary skill in the art to make and use the invention recited in the claims. Since one of ordinary skill in the art would presume, based at least on common sense, that at some point the porthole engine had to request content that the porthole engine had not previously requested or obtained, one of ordinary skill in the art does not need to have this fact expressly stated to him in order to understand how to make and use the invention. The addition of the phrase “wherein, when said porthole engine responds to said initial request, said porthole engine has not yet obtained any copy of said requested content from said origin server” to Claim 1 does not suddenly and magically cause one of ordinary skill in the art to scratch his head in puzzlement and wonder how such a thing could possibly be accomplished. The addition of this phrase to Claim 1 merely causes Claim 1 to cover a specific set of conditions—the condition in which the porthole engine hasn’t yet requested the requested content from the origin server when the porthole engine responds to the initial request. One of ordinary skill in the art knows that such a condition must occur at a time shortly after the porthole engine initially starts up, when the porthole engine has never obtained any requested content from any origin server.

MPEP 2164 states that “the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed **does not** necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation **in and of itself may enable** one skilled in the art to make and use the claim containing that limitation **even though that limitation may not be described in the original disclosure.**” Thus, even if the original specification does not expressly say “wherein, when said porthole engine responds to

said initial request, said porthole engine has not yet obtained any copy of said requested content from said origin server,” this does **not** imply that the limitation is not enabled.

MPEP 2164 also says that the standard for determining whether the specification meets the enablement requirement is whether or not the **experimentation** needed for one of ordinary skill in the art to practice the invention is **undue** or **unreasonable**. The Office Action has not set forth any reasoning that would show that the experimentation required by one of ordinary skill in the art to practice a version of the invention in which “the porthole engine has not yet obtained any copy of the requested content from the origin server when the porthole engine responds to the request” would be unreasonable or undue. To the contrary, if one of ordinary skill in the art were to make and use any embodiment of the invention that is specifically set forth in the specification as filed, the resulting embodiment of the invention **would, in fact**, be one in which the porthole engine had not yet obtained any copy of the requested content from the origin server at the time that the porthole engine responded to the **first** request for that content. One of ordinary skill in the art would not need to conduct **any experimentation at all** in order to practice the embodiment of the invention that is recited in Claim 1. Therefore, Claim 1 satisfies the enablement requirement of 35 U.S.C. § 112, first paragraph.

Claims 25 and 49 satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph, for at least the same reasons that Claim 1 satisfies the enablement requirement of 35 U.S.C. § 112, first paragraph.

Claims 4, 28, and 52

Claims 4, 28, and 52 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleged that

the feature “said porthole engine sending said data to said client before said requested content is ever requested from the origin server due to any request by said client” is not described in the specification. The Office Action alleges that such a feature is not **explicitly** described in the specification.

Starting on page 14 of the specification, an embodiment of the invention is described with reference to FIG. 3. The steps performed in this embodiment are shown in a particular order. In such an embodiment, the porthole engine clearly performs step 2 before the porthole engine performs step 4. Step 2 involves the porthole engine sending frameset data (an example of the “data generated by the porthole engine” as recited in Claim 1 and “said data” as recited in Claim 4) to the user who requested the requested content. Step 4 involves the porthole engine forwarding requests for specified content (an example of “said requested content”) from the appropriate servers in response to requests that the browser sent toward the porthole server in the earlier step 3. Thus, the specification clearly sets forth an embodiment of the invention in which the porthole server sends the porthole engine-generated data (e.g., “frameset data”) to the client before the porthole engine requests or obtains the requested content (e.g., “<http://www.cajun-gifts.com/>”) from the origin server due to any request by the client.

As is discussed above with regard to Claim 1, one of ordinary skill in the art who followed the detailed description set forth in the specification would, **without any experimentation at all**, be able to make and use an embodiment of the invention in which, when the porthole engine was first started, the porthole engine had not yet issued any requests for content to any origin servers. It would only be natural for the porthole engine to begin in this state when started up. Indeed, it is difficult to conceive of an embodiment in which the porthole engine would not be in such a state initially. In such an embodiment of the invention, when the

porthole engine receives the first request from a client for requested content, it is a fact that the porthole engine will not have requested or obtained that content from any origin server—since the porthole engine just started. Thus, under such circumstances, when the porthole engine sends the frameset data to the client in response to the first request, the porthole engine does so at a time at which the porthole engine has not yet requested or obtained the requested content from the appropriate origin server.

Although the specification might not **expressly** state that, under some circumstances, the porthole engine has not ever requested or obtained the requested content from the origin server at the time that the porthole engine sends the frameset data to the client in response to client's request for the content, one of ordinary skill in the art understands that the embodiment disclosed in the specification will exhibit such behavior at some point—at least the first time that the porthole engine receives a request for requested content. It is not necessary for the specification to expressly set forth information that would be logically concluded by one of ordinary skill in the art who had read the specification.

Indeed, it is apparent to one of ordinary skill in the art that, in one embodiment of the invention, whenever the server performs the technique illustrated with reference to FIG. 3, the porthole engine will always perform step 2 before performing step 4. One of ordinary skill in the art realizes that, for any unique item of requested content that a client could request, there must be a first time that the porthole engine has ever received a request for that particular content, and under such circumstances, the porthole engine will respond to the client's request with frameset data (step 2) before requesting and obtaining the particular content from the appropriate origin server (step 4). Under such circumstances, the porthole engine will have sent the frameset data

to the client before the particular content was **ever** requested or obtained from the origin server due to any request by the client.

Thus, Claim 4 recites a method that will be performed, if not every time that the porthole engine receives a request from a client, then at least **some** times that the porthole engine receives a request from a client. No undue or unreasonable experimentation would need to be performed by one of ordinary skill in the art, after reading the specification, to make and use an embodiment of the invention that naturally performed the method of Claim 4 at least some time. Indeed, no experimentation at all would need to be performed by such a person of ordinary skill in the art.

As is discussed above, MPEP 2164 indicates that the test for a claim's enablement is whether one of ordinary skill in the art would, after reading the specification, be able to make and use the invention recited in the claim without undue experimentation. In this case, one of ordinary skill in the art clearly would, after reading the specification, be able to make and use the embodiment of the invention that possesses all of the features recited in Claim 4. As a result, Claim 4 satisfies the enablement requirement of 35 U.S.C. § 112, first paragraph.

Claims 28 and 52 satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph, for at least the same reasons that Claim 1 satisfies the enablement requirement of 35 U.S.C. § 112, first paragraph.

CLAIM REJECTIONS—35 U.S.C. § 103

Claims 1, 2, 4-13, 16-19, 25, 26, 28, 31-37, 40-43, 49, 50, 52, 55-62, and 65-67

Claims 1, 2, 4-13, 16-19, 25, 26, 28, 31-37, 40-43, 49, 50, 52, 55-62, and 65-67 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,317,761

(“Landsman”) in view of U.S. Patent No. 6,553,393 (“Eilbott”) and U.S. Patent No. 6,249,844 (“Schloss”). This rejection is respectfully traversed.

The Office Action admits, on page 4, that neither Landsman nor Eilbott teach the feature “wherein, when said porthole engine responds to said initial request, said porthole engine has not yet obtained any copy of said requested content from said origin server.” The Office Action alleges that Schloss discloses this feature in col. 4, lines 58-62.

This portion of Schloss says, “. . . the client can . . . let the proxy server interpret the markup language describing the fragment and generate an appropriate version for the client.” Thus, the Office Action relies on this portion of Schloss as standing for the proposition that Schloss’ proxy server generates data that the proxy server sends to the client. The reason why Schloss’ proxy server would generate the markup language instead of letting the client do so is because the client is unable to do so itself own due to processing power or storage limitations of the client device (col. 4, lines 62-65).

However, the mere fact that the more powerful proxy server interprets part of the document on behalf of the weaker client does not imply that the proxy server did not, prior to sending that server-interpreted part to the client, receive any copy of the document (the alleged “requested content”) from the web server (the alleged “origin server”). Clearly, the proxy server cannot interpret any part of the document on behalf of the client until the proxy server has already requested and obtained the document, at least once, from the web server that serves the document. It is true that the proxy server can, thereafter, cache the document and interpret portions thereof for the client without re-requesting the document from the web server, but this can occur only after the proxy server has requested the document from the web server at least

once. If the proxy server has not yet obtained the document from the web server, then there is no way that the proxy server can interpret any part of that document on behalf of the client.

Additionally, the part of the document that Schloss' proxy server interprets on behalf of the client is not data that "causes the client to request the requested content" as required by Claim 1. Presumably, after Schloss' proxy server has interpreted the document portion on behalf of the client, there is no need for the client to request that portion of the document thereafter. It would not even make sense to modify (based on some teaching from Landsman or Eilbott) Schloss' proxy server so that the document portion interpreted by the proxy server would cause the client to request the portion. There simply is no reason to do so. Once Schloss' client has the interpreted portion from the proxy server, the client does not need to request that portion thereafter.

Therefore, Schloss, considered individually, does not disclose "wherein, when said porthole engine responds to said initial request, said porthole engine has **not yet obtained any copy of said requested content** from said origin server" as recited in Claim 1. As is mentioned above, the Office Action admits that Landsman and Eilbott do not disclose this feature of Claim 1. Therefore, even if Schloss, Landsman, and Eilbott could be combined, the combination would not teach, disclose, or suggest the method of Claim 1.

The Office Action alleges that the one would have been motivated to combine Schloss, Landsman, and Eilbott because doing so would "avoid the transfer of data to other servers." However, neither Schloss, Landsman, nor Eilbott seems to have, as its object or result, the avoidance of the transfer of data to a server. None of these references appears to be even remotely concerned with avoiding such a transfer. The Office Action does not cite any portion of any of the references in support of the theory that the combination thereof would avoid such a

transfer. Actually, a theoretical combination of Schloss, Landsman, and Eilbott would **not** avoid a transfer of data to “another server” (if such a transfer were even taking place—it is not apparent at all to what transfer the Office Action could be referring; none of the cited references appears to disclose an approach that even involves a transfer of data to “another server”). This purported motivation to combine appears to be plucked out of thin air without any support or explanation whatsoever. One of ordinary skill in the art would not have combined the teachings of Schloss, Landsman, and Eilbott to avoid the transfer of data to other servers, as alleged by the Office Action. Although the bar for establishing a *prima facie* case of obviousness appears to be set fairly low these days, the Applicants are fairly confident that the bar is at least high enough that the purported motivation to combine must at least make sense in order to establish the *prima facie* case.

For at least the above reasons, Claim 1 is patentable over Schloss, Landsman, and Eilbott, taken individually or in combination, under 35 U.S.C. § 103(a).

Claims 2, 4-13, 16-19, 25, 26, 28, 31-37, 40-43, 49, 50, 52, 55-62 and 65-67 are patentable over Schloss, Landsman, and Eilbott under 35 U.S.C. § 103(a) for at least the reasons discussed above in connection with Claim 1.

Claims 14, 15, 38, 39, 63, and 64

Claims 14, 15, 38, 39, 63, and 64 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Landsman, Eilbott, and Schloss in view of U.S. Patent No. 6,606,653 (“Ackermann”). This rejection is respectfully traversed.

Claim 14 recites “wherein the step of sending data to said client includes the step of rewriting a link **in an embedded frame document to affect frame behavior.**” The cited

portion of Ackerman admittedly concerns the updating of a link, but there is absolutely **no** disclosure, teaching, or suggestion **anywhere** in Ackermann that the updated link is “in an embedded **frame** document” or that the updating of the link “**affects frame behavior.**” Ackermann does not contain even the slightest mention of frames or frame behaviors. Therefore, taken individually, Ackermann does not teach, disclose, or suggest the method of Claim 14.

The Office Action admits that Landsman, Eilbott, and Schloss all fail to teach this feature of Claim 14. Therefore, even if Landsman, Eilbott, Schloss, and Ackermann could be combined somehow, the combination still would not teach, disclose, or suggest the method of Claim 14. For at least the above reasons, Claim 14 is patentable over Landsman, Eilbott, Schloss, and Ackermann, taken individually or in combination, under 35 U.S.C. § 103(a).

Claims 15, 38, 39, 63 and 64 are patentable over Schloss, Landsman, Eilbott, and Ackermann under 35 U.S.C. § 103(a) for at least the reasons discussed above in connection with Claim 14.

Claims 20, 44, and 68

Claims 20, 44, and 68 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Landsman, Eilbott and Schloss further in view of U.S. Patent No. 6,704,873 (“Underwood”). This rejection is respectfully traversed.

Claim 20 inherits the features of Claim 1 that are distinguished over Landsman, Eilbott, and Schloss above. The Office Action does not even allege that Underwood teaches, discloses, or suggests these distinguished features. Therefore, even if Landsman, Eilbott, Schloss, and Underwood could be combined somehow, the combination still would not teach, disclose, or suggest all of the features of Claim 20. Consequently, Claim 20 is patentable over Landsman,

Eilbott, Schloss, and Underwood, taken individually or in combination, under 35 U.S.C. § 103(a).

Claims 44 and 68 are patentable over Schloss, Landsman, Eilbott, and Underwood under 35 U.S.C. § 103(a) for at least the reasons discussed above in connection with Claim 20.

Claims 21-23, 45-47, and 69-71

Claims 21-23, 45-47, and 69-71 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Landsman, Eilbott, and Schloss in view of U.S. Patent No. 6,499,042 (“Markus”). This rejection is respectfully traversed.

Claim 21 recites “wherein the requested content includes a web page form, and the **unrequested** content includes information that automatically fills in one or more fields of said web page form.” Thus, according to Claim 21, the “information that automatically fills in one or more fields” must be included within **unrequested** content.

In Markus, both the document browser and the external entity (e.g., user) that controls the document browser **actually request**, from the selective proxy, that the selective proxy fill in the form (see, for example, col. 3, lines 25-30, which say, in relevant part, “After the Document Server returns the requested document in 18, the **external entity activates a form autofill trigger** located in the recently loaded document as shown in 19. The autofill trigger **causes the Document Browser to contact the Selective Proxy** as depicted by the line marked 20.”) Since both the external entity (e.g., user) and the document browser **actually request** that the selective proxy fill in the form, Markus’ approach does **not** teach, disclose, or suggest that the “information that automatically fills in one or more fields” is included within **unrequested** content.

Therefore, Markus, taken individually, does not disclose, teach, or suggest “wherein the requested content includes a web page form, and the **unrequested** content includes information that automatically fills in one or more fields of said web page form” as recited in Claim 21. The Office Action admits that Landsman, Eilbott, and Schloss all fail to teach this feature of Claim 21. Therefore, even if Landsman, Eilbott, Schloss, and Markus could be combined somehow, the combination still would not teach, disclose, or suggest the method of Claim 21. For at least the above reasons, Claim 21 is patentable over Landsman, Eilbott, Schloss, and Markus, taken individually or in combination, under 35 U.S.C. § 103(a).

Claims 22, 23, 45-47, and 69-71 are patentable over Schloss, Landsman, Eilbott, and Markus under 35 U.S.C. § 103(a) for at least the reasons discussed above in connection with Claim 21.

Claims 24, 28, and 72

Claims 24, 48, and 72 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Landsman, Eilbott, and Schloss in view of U.S. Patent No. 5,991,810 (“Shapiro”). This rejection is respectfully traversed.

Claim 24 inherits the features of Claim 1 that are distinguished over Landsman, Eilbott, and Schloss above. The Office Action does not even allege that Shapiro teaches, discloses, or suggests these distinguished features. Therefore, even if Landsman, Eilbott, Schloss, and Shapiro could be combined somehow, the combination still would not teach, disclose, or suggest all of the features of Claim 24. Consequently, Claim 24 is patentable over Landsman, Eilbott, Schloss, and Shapiro, taken individually or in combination, under 35 U.S.C. § 103(a).

Claims 48 and 72 are patentable over Schloss, Landsman, Eilbott, and Shapiro under 35 U.S.C. § 103(a) for at least the reasons discussed above in connection with Claim 24.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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